

Appl. No. 09/557,597  
Amendment and/or Response  
Reply to Office action of 19 October 2004

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### REMARKS / DISCUSSION OF ISSUES

Claims 1-2, 4-10, and 13-27 are pending in the application. Claims 19-27 are newly added.

The Office action rejects claims 1 and 14 under 35 U.S.C. 102(b) over Duhamc et al. (USP 5,541,585, hereinafter Duhamc). The applicants respectfully traverse this rejection, based on the applicants' remarks in prior responses, and based on the following remarks.

The Examiner's attention is requested to MPEP 2131, wherein it is stated:

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The *identical invention* must be shown in as *complete detail* as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 claims a system that includes a gatekeeper device that is configured to selectively transmit a user identification in response to receipt of a communication from the apparatus.

Duhamc does not teach a gatekeeper device that is configured to selectively transmit a user identification in response to receipt of a communication from the apparatus, as specifically claimed in claim 1.

Claim 14 claims a method of facilitating personalization of a plurality of apparatuses that includes selectively communicating a user identification to each apparatus, in response to a communication from each apparatus.

Duhamc does not teach selectively communicating a user identification to each apparatus, in response to a communication from each apparatus, as specifically claimed in claim 14.

In response to the applicants' prior remarks, the Examiner asserts that "it is noted that the features upon which the applicant relies (i.e. *selectivity*) are not recited in the rejected claims" (Office action, page 2, last full sentence). The applicants respectfully disagree with this assertion, because claim 1 specifically recites "... *selectively* transmit a user identification" and claim 14 specifically recites "... *selectively* communicating a user

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identification". The claims specifically include *selectively* transmitting or communicating a user identification, whereas Duhamel does *not* teach or suggest *selectively* transmitting or communicating a user identification.

Duhamel repeatedly teaches "*automatically* transmitting" an identification code to an interrogation device, and specifically distinguishes this automatic transmission as a key feature of the invention. The Office action specifically acknowledges that Duhamel teaches an automatic transmission: "When portable device 18 receives the interrogation signal from the fixed transceiver 16, it *automatically* transmits the response signal" (Office action, page 3, lines 13-15). The applicants respectfully maintain that the teaching of an *automatic* transmission cannot be said to teach the applicants' claimed *selective* transmission, because as the terms "automatic" and "selective" are conventionally used in the art, and consistent with their use in Duhamel and the applicants disclosure, the terms "automatic" and "selective" are mutually exclusive.

The Office action apparently equates the phrase "selectively select a code to automatically transmit", as taught by Duhamel, with the phrase "selectively transmit an identification code", as claimed by the applicants (Office action, page 3, last sentence of first full paragraph). The applicants respectfully maintain, however, that such a juxtaposition of adverbs defining different verbs does not produce an equivalent phrase. (For example, the phrase "quickly running and slowly stopping" has an entirely different meaning than the phrase "slowly running and quickly stopping", even though they contain an identical set of words. Neither the "slowly running" or "quickly stopping" terms are a proper interpretation of the original "quickly running and slowly stopping" phrase.) Adverbs qualify/limit verbs. The applicants limit the claims to a device that *selectively transmits* an identification code. Duhamel limits his teaching to a device that *automatically transmits* a selected identification code. These two limitations are not equivalent, and, as the terms are used in the art, are contrary to each other.

Because Duhamel does not teach each of the elements of the applicants' claims 1 and 14, the applicants respectfully request the Examiner's reconsideration of the rejection of claims 1 and 14 over Duhamel.

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The Office action rejects:

claims 2, 4, 6, 10, and 15-16 under 35 U.S.C. 103(a) over Duhamé and Brinkmeyer et al. (USP 5,983,347, hereinafter Brinkmeyer);

claim 5 under 35 U.S.C. 103(a) over Duhamé, Brinkmeyer, and Kushiro et al. (USP 6,285,357, hereinafter Kushiro); and

claims 8-9, 13, and 17-18 under 35 U.S.C. 103(a) over Duhamé and Nickum (USP 6,359,661).

The applicants respectfully traverse these rejections.

In each of these rejections, the Office action specifically relies upon Duhamé for teaching the elements of claims 1 and 14 (Office action page 6, last sentence; page 7, last (partial) sentence; page 8, first full sentence; page 8, third full paragraph; page 9, last (partial) sentence; and page 10, last sentence). As noted above, Duhamé does not teach selectively transmitting a user identification, as specifically claimed in each of claims 1 and 14, and also in each of independent claims 8 and 10.

The Examiner's attention is requested to MPEP 2142, wherein it is stated:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) *must teach or suggest all the claim limitations*." Further: "The examiner bears the initial burden of factually *supporting* any *prima facie conclusion* of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

Because Duhamé does not teach or suggest the elements of the claims upon which these rejections are based, the applicants respectfully maintain that a *prima facie* case of obviousness has not been presented, and respectfully request the Examiner's reconsideration of these rejections in view of the remarks above regarding Duhamé.

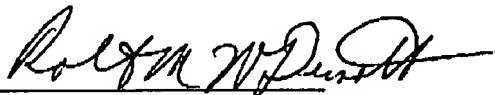
With regard to the newly added claims, 19-27, the applicants offer the following remarks. These claims specifically recite receiving an identification of an apparatus, and selectively transmitting a user identification based on a state of a gatekeeper/portable device relative to the apparatus. Neither Duhamé, nor Brinkmeyer, nor Kushiro, nor Nickum teach or suggest selectively transmitting a user identification based on a state of a gatekeeper/portable device relative to the apparatus.

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In view of the foregoing, the applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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ADDITIONAL CLAIMS (2@200 + 4@50)

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